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10/733,500

12/11/2003

Randall E. Butler

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FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON, TX 77010-3095

EXAMINER

MEYERS, MATTHEW S

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/733,500	Applicant(s) BUTLER, RANDALL E.	
	Examiner MATTHEW S. MEYERS	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's communication on 12/11/03, wherein claims 1-41 are currently pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant invention requires a user to submit a counter-offer from the second party. What if there is no counter-offer? What occurs if the dispute is not settled?

4. Claims 21-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has recited in the preamble "a computer-usable" medium. Examiner is unclear as to what applicant is intending by "computer-usable" and suggests computer-readable.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 1-20, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 4-17, 19, 21, 24-38, and 40 rejected under 35 U.S.C. 102(e) as being anticipated by Collins (Pub. No.: US 2002/0007362).

9. With respect to **Claims 1 and 21**:

10. Collins discloses a computer-implemented method of on-line dispute resolution for a dispute, said method and computer-usable medium having computer-readable program code embodied therein for causing a computer to perform the steps of comprising:

- a. (a) receiving a settlement offer from a first party (Collins Fig. 11); and
- b. (b) presenting said settlement offer from said first party to a second party (Collins Fig. 11, item 1150 and 12b, item 1211);
- c. (c) receiving a settlement counter-offer from said second party (Collins Fig. 12b, item 1213);
- d. (d) presenting said settlement counter-offer to said first party (Collins Fig. 12c, item 1231); and
- e. (e) repeating steps (a)-(d) until the dispute is settled (Collins Fig. 8c, item 845, "Agreement Reached?").

11. With respect to **Claims 4 and 24**:

12. Collins discloses wherein the settlement offer comprises one or more settlement offers (Collins Fig 8b).

13. With respect to **Claims 5 and 25**:

14. Collins discloses wherein the settlement counter-offer comprises one or more counter-offers (Collins Figs. 12a, 12b, 12c, 12d, and 12e).

15. With respect to **Claims 6 and 26**:

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16. Collins discloses wherein step (a) and step (c) is limited to a time duration after which no further offers or counter-offers may be received (Collins [0063], "These options may also be presented to the parties, for example, at the expiration of a predetermined time limit or at regular time intervals throughout the structured negotiation session.").

17. With respect to **Claims 7 and 27:**

18. Collins discloses wherein the settlement offer is associated with a group negotiation number (Collins Fig 7a, "Case Reference #").

19. With respect to **Claims 8 and 28:**

20. Collins discloses generating a report for presentation to said first party, said report summarizing the settlement offers made by second party (Collins Figs. 12a, 12b, 12c, 12d, and 12e).

21. With respect to **Claims 9 and 29:**

22. Collins discloses generating a report for presentation to said second party, said report summarizing the settlement offers made by the first party (Collins Figs. 12a, 12b, 12c, 12d, and 12e).

23. With respect to **Claims 10 and 31:**

24. Collins discloses wherein the first party is a group of one or more claimants, and the offer is an aggregate group offer from the claimants; the second party is a group of one or more defendants and the counter-offer is made as individual offers from each of the defendants (Collins Figs. 12a, 12b, 12c, 12d, and 12e).

25. With respect to **Claims 11 and 32:**

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26. Collins discloses wherein the first party is a group of one or more defendants, and the offer is an aggregate group offer from the defendants; the second party is a group of one or more claimants and the counter-offer is made as individual offers from each of the claimants (Collins Figs. 12a, 12b, 12c, 12d, and 12e).

27. With respect to **Claims 12 and 33**:

28. Collins discloses settling the dispute for the claimants and defendants when the sum of the individual demands is equal to or greater than the aggregate group offer (Collins Figs. 12a, 12b, 12c, 12d, and 12e).

29. With respect to **Claims 13 and 34**:

30. Collins discloses generating one or settlement documents when the dispute is settled (Collins Fig 13).

31. With respect to **Claims 14 and 35**:

32. Collins discloses receiving a dispute registration for said dispute; and storing said dispute registration into a database with a unique dispute identifier (Collins Fig 7a, "Case Reference #").

33. With respect to **Claims 15 and 36**:

34. Collins discloses providing to said first and second party each a unique access identifier, said unique access identifier associated to said dispute identifier (Collins Fig 7a, "Case Reference #" and Fig 10).

35. With respect to **Claims 16 and 37**:

36. Collins discloses displaying a set of questions related to said dispute to said first party; receiving a first set of general exchange information from said first party;

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displaying to a second party, said set of questions related to said dispute; and receiving a second set of general exchange information from said second party (Collins Fig 11).

37. With respect to **Claims 17 and 38**:

38. Collins discloses presenting a comparison of said first and second sets of general exchange information, said comparison identifying matching and non-matching general exchange information (Collins Fig 12a).

39. With respect to **Claims 19 and 40**:

40. Collins discloses wherein said questions are determined for presentation based on a dispute type (Collins [abs], "Further, the situation may comprise a plurality of issues, each requiring a separate resolution. A plurality of retrieved sets of resolutions are sent to each of the plurality of parties in the form of one or more templates.

Refinement of the issues may occur by either of the parties which will cause an alternative set of resolutions based on additional data provided by at least one of the parties. Each issue which is part of the situation may be refined and a new set of resolutions provided. The issues are refined until an agreement is reached or the parties determine that an alternative dispute mechanism is required.").

41. With respect to **Claim 30**:

42. Collins discloses wherein said computer-readable program code embodied therein causes a computer to further perform the step of: notifying the first party and the second party of the mean value (Collins Figs. 12a, 12b, 12c, 12d, and 12e).

Claim Rejections - 35 USC § 103

43. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

44. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

45. Claims 2-3, 18, 20, 22-23, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins as applied to claims 1, 4-17, 19, 21, 24-38, and 40.

46. With respect to **Claims 2-3 and 22-23**:

47. Collins discloses all the above limitations. Collins additionally discloses wherein each party may have two separate opportunities to vent and to clarify the issues (Collins [0049]. Collins does not explicitly disclose wherein the first party comprises one or more claimants and the second party comprises one or more defendants or wherein the first party comprises one or more defendants and the second party comprises one or more claimants. It would have been obvious to one of ordinary skill in the art at the time of the invention to have labeled these adversarial parties as a claimant or as a defendant since they are operating as either a claimant or defendant. When one party initiates

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mediation or arbitration (Collins Fig. 8a) they are adversarial parties, one being the claimant and the other the defendant. Thus, it would have been obvious to have incorporated this nomenclature, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

48. With respect to **Claims 18 and 39:**

49. Collins discloses all the above limitations. Collins additionally discloses receiving information from a first party and a second party (Collins Figs. 12a, 12b, 12c, 12d, and 12e). Collins does not explicitly disclose receiving a first set of private exchange information from said first party; and receiving a second set of private exchange information for said second party; wherein the first set of private exchange information is not viewable by the second party; and the second set of private exchange information is not viewable by the first party. It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated a private exchange of information which is not viewable by the adversarial party because of the nature of the negotiation. Confidentiality has existed within the zone of negotiations, mediation and arbitration and it would have been obvious to incorporate a private exchange of information which the other party would not be able to access in an effort to preserve a users remedies down the road, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

50. With respect to **Claims 20 and 41:**

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51. Collins discloses all the above limitations. Collins additionally discloses the creation of a binding agreement (Collins Fig 13). Collins does not explicitly disclose wherein the settlement offer or the settlement counter-offer is a non-suit request.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow the option for a claimant to voluntarily withdrawal or dismiss his claim against the defendant, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW S. MEYERS whose telephone number is (571)272-7943. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Meyers/
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689